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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,010	09/13/2000	Joseph T. Pych	NMC-001.01	8285
25181	7590	04/19/2006	EXAMINER	
FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110			GOTTSCHALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/661,010	PYCH, JOSEPH T.
	Examiner	Art Unit
	Martin A. Gottschalk	3626

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 September 2005.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3,5,7,8,12-14,16,19-23,25,27,28,32-34,36 and 39-44 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3,5,7,8,12-14,16,19-23,25,27,28,32-34,36 and 39-44 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date 11/11/2005.

4) Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. Claims 1, 3, 5, 7, 8, 12-14, 16, 19-23, 25, 27, 28, 32-34, 36, and 39-44 have been examined. Claims 4, 6, 9-11, 15, 17, 18, 24, 26, 29-31, 35, 37, 38 have been cancelled.

### ***Specification***

2. As per the amendment to the specification which corrects the defect described in the previous Office Action, this objection is hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, both claims depend from cancelled claims 6 and 26 respectively, thus rendering them indefinite. Correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 5, 7, 8, 12-14, 16, 19-23, 25, 27, 28, 32-34, 36, and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over VALEX User Guide (hereinafter Valex) in view of Resnick, Rosalind, "Netcreations releases Postmaster Direct Response 2.0 Real-Time List Ordering System for the Web" (hereinafter Netcreations), and further in view of Wilkins et al (US Patent# 6,868,389, hereinafter Wilkins).

A. As to claim 1, Valex discloses a method of acquiring a list of prospective customers over a computer network, the prospective customer list including one or more attributes for each prospective customer on the list, the method comprising:

receiving a location of the list on the computer network from a client system (i.e. configuring query and table selection)(Chapter 1) ,

retrieving the list from the location (Chapter 1)

formatting the list for storage in a database of prospective customer lists (i.e. extract)(chapter 2 and Fig. 2-2), the formatting facilitating searching and retrieval of the list and data included therein from the database (chapter 2)

Valex does not explicitly disclose

storing the formatted list in the database of prospective customer lists.

However, Netcreations discloses storing the list with prospective customer lists (i.e., offers more than 3000 lists)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Netcreations within Valex for the motivation of offering automated realtime list availability to list purchasers (page 1)

The combined teachings of Valex and Netcreations fail to explicitly disclose

wherein the formatting further comprises:

- (a) identifying the attributes included in the list received from the client system,

- (b) comparing the identified attributes with database attributes, each database attribute being pre-defined by the database of prospective customer lists and having a pre-defined format,

and

- (c) creating a new database attribute for an identified attribute if no match is determined between the identified attribute and a database attribute.

However, Wilkins teaches

wherein the formatting (Wilkins: col 8, Ins 49-50; col 9, Ins 15-42) further comprises:

- (a) identifying the attributes included in the list received from the client system (Wilkins: col 6, Ins 14-17, reads on "prospect identifier"; col 6, Ins 48-55, reads on "auxiliary data"),
- (b) comparing the identified attributes with database attributes, each database attribute being pre-defined by the database

of prospective customer lists and having a pre-defined format (Wilkins: col 6, ln 63 to col 7, ln 9; col 9, lns 43-53),

and

- (c) creating a new database attribute for an identified attribute if no match is determined between the identified attribute and a database attribute (Wilkins: col 9, lns 59-64).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Wilkins with the combined teachings of Valex and Netcreations for the motivation of providing leads that indicate buying intent versus mere past purchasing behavior (Wilkins: col 2, 55-59).

B. As per claims 3, 7, 8, 12-14, 16, 19, 20, and 41-44, they are currently unamended, save for the amendment to claim 1 above, and are thus rejected for the same reasons provided in the first Office Action.

C. As per claim 5, the amendment to it serves only to re-establish its dependency from claim 1 due to the cancellation of claim 4 from which it previously depended. The

substance of the claim remains unchanged, and is thus rejected for the same reasons provided in the previous Office Action.

D. As to claims 21-23, 27, 28 32-34, 36, 39 and 40, the claims are substantially similar in scope to claims 1-3, 7, 8, 12-14, 16, 19 and 20 and are rejected on the same basis.

E. As per claim 25, the amendment to it serves only to re-establish its dependency from claim 21 due to the cancellation of claim 24 from which it previously depended. The substance of the claim remains unchanged, and is thus rejected for the same reasons provided in the previous Office Action.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 and 21 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*MG*

MG  
03/29/2006

*Joseph Thomas*  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER